

REMARKS

The Office Action dated October 6, 2003 has been carefully considered.

It is noted that Claims 1-7 are rejected under 35 USC § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is believed that the above amendments to the Claims 1-7 are fully responsive to the Examiner's rejection.

Claims 1-5 and 7 are rejected under 35 USC §102 (b) as being anticipated by Beller, U.S. Patent 4,979,413 ("Beller").

Applicant believes that Beller teaches a much more complex invention than the invention of the present application, by focusing on complex embodiments such as claimed in the Beller patent. Thus, applicant believes that Beller teaches away from the simplicity of the present invention, which provides solution to the problem of measuring and trimming piping salvage with a minimum of manufacturing steps and complex apparatus. See *In re Baird*, 16 F.3d 380, 29 U.S.P.Q.2d 1550 (Fed. Cir. 1994) (prior art reference "appears to teach away from the selection of "the claimed composition "by focusing on more complex examples"). The fact that a simple solution has escaped others in the art is some evidence that it was not obvious to a person of ordinary skill in the art. See *In re Shelby*, 311 F.2d 807, 810, 136 U.S.P.Q. 220 (CCPA 1963):

Appellant's claimed invention departs from the prior art in the direction of simplicity rather than in the direction of complexity ... The simplicity of this useful invention is, in retrospect, some evidence that it was not obvious to a person of ordinary skill in the art *In re Osplact*, 39 CCPA 932, 195 F.2d 921, 93 U.S.P.Q. 306. . . . While it is admittedly simple, it has escaped the other workers in this crowded art. We do not think the simplicity of appellant's construction should deprive him of his right to a patent thereon. *Expanded Metal Co. v. Bradford*, 214 U.S. 366.

Beller utilizes a complex tool consisting of multiple blocks, springs, a sponge, a razor blade and other structure. The present invention utilizes one tool and a cutting devices. Distinguishing further, the welt material is completely encased in

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the tool and pulled-through and cut with a stationary razor bladed. In contrast, the present invention is placed on top of the piping material (with only one side of the tool in contact with the material) and a cutting apparatus is placed next to the tool and drawn along the cutting guide edge of the tool.

Claims 1-6 are rejected under 35 USC §102 (b) as being anticipated by Kubo, U.S. Patent 4,625,464 ("Kubo").

Like the invention disclosed in Beller, the Kubo patent disclosed a complex tool. However, Kubo disclosed a tool for cutting metal or plastic tubing. Moreover, the tool disclosed in Kubo is used to cut the ends of the tubing to a specific length where as the present invention is used to cut the salvage material which is parallel to the cording of the piping. The Kubo tool utilizes rollers to allow the pipe to be rotated in the tool to allow a stationary positioned rotary cutting blade to cut the pipe. In the method of the present invention, the piping material is stationary in the piping trimming tool and only the cutting apparatus is moved along the cutting guide. Claims 1-7 are not directed to a method of cutting metal or plastic pipe. Therefore, it is respectfully submitted that Kubo is not relevant to the present invention.

It is noted that claims 1 and 6 are rejected under 35 USC §103(a) as being unpatentable over McCormick, U.S. Patent No. 5,823,086 ("McCormick") in view of Mitchell, U.S. Patent 4,724,327 ("Mitchell").

Claim 1 and dependent claim 6 claim a piping trimming tool which utilizes a holding device consisting of a channel to hold both fabric and a cord. Conversely, McCormick utilizes a tool having a rail that is placed on a material to trim the edges of the fabric. Mitchell is cited for disclosing that it is well known in the art of cut piping material. However, Mitchell discloses cutting the edges of the piping and not the trimming of the salvage material as disclosed in the present invention.

It is further noted that claims 8 - 18 are rejected under 35 USC §103(a) as being unpatentable over Beller in view of Hanson et al., U.S. Patent No. 4,615,116 ("Hanson"). As stated above, Beller discloses a complex tool that teaches away from the simplicity of the present invention. Hanson, like Beller also discloses a complex tool that is used to slit the outer insulation of cable without cutting the cable encased in

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the insulation. Applicant believes that Hanson teaches away from using a tool placed on top of piping to cut the salvage of the piping material. It is respectfully submitted that Hanson is not relevant to the present invention.

It is further noted that claims 8 - 20 are rejected under 35 USC §103(a) as being unpatentable over McCormick in view of Hanson. Although Hanson utilizes a transparent body it is directed to a method of slitting insulation on cable. McCormick is not relevant to the present invention and not obvious to one skilled in the art to combine the teaches of Hanson with those of McCormick.

In view of the Examiner's rejection of the claims over the art, Applicant has amended claims 1-7 to further include the limitations and clarifications to overcome the prior art.

It is respectfully submitted that the amended claims clearly and patentably distinguish over the prior art, since it is believed that the construction defined in these claims differs essentially and in an unobvious, highly advantageous manner from the constructions disclosed in the references. Applicant believes that combining the references discussed above would not lead to the claimed invention, in that the present invention does not merely employ the known substitution of equivalents but rather employs a new, non-obvious combination to accomplish the objections set out in the present application.

As for the proposed combination of references cited by the examiner, it is respectfully submitted that since none of the references in the combination teaches the distinctive features of applicant's invention as defined in the claims, any hypothetical construction produced by this combination would not lead to applicant's invention.

In view of these considerations, Applicant respectfully submits that the rejection of the original claims should be considered as no longer tenable with respect to amended claims 1-20 and should be withdrawn.

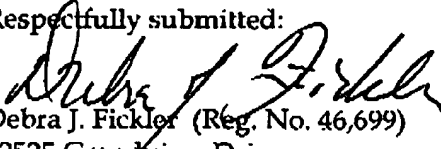
Should the Examiner consider necessary or desirable any formal changes anywhere in the specification, claims and/or drawings, then it is respectfully asked that such changes be made by Examiner's Amendment, if the Examiner feels this

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would facilitate passage of the case to issuance. Alternatively should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned at 847-669-3117 or 847-274-5414.

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